



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,915	08/04/2003	John R. Frank	113744.123 (US2)	7574
23483 7590 09/04/2007 WILMER CUTLER PICKERING HALE AND DORR LLP 60 STATE STREET BOSTON, MA 02109			EXAMINER LIN, WEN TAI	
			ART UNIT 2154	PAPER NUMBER
			NOTIFICATION DATE 09/04/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

michael.mathewson@wilmerhale.com
teresa.carvalho@wilmerhale.com
tina.dougal@wilmerhale.com

Office Action Summary

Application No.

10/633,915

Applicant(s)

FRANK, JOHN R.

Examiner

Wen-Tai Lin

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 and 27 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. Claims 1-8 are presented for examination.
2. Claims 1-8 is/are objected to because the following terms lack antecedent basis:
in claim 1: "those electronic files";
in claim 3: "said first-mentioned client document" and "the first-mentioned client".

Further, claim 3 is objected to because the phrase "plurality client documents" appear to be a typo of "plurality of client documents".

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2154

4. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Singh et al.[U.S. PGPub 20020091758].

5. As to claim 1, Singh teaches the invention as claimed including: a method implemented by a client application running on a computer, said method comprising:
retrieving an address associated with a server [note that in a client-server network environment a client must communicate with the server with a network address] that provides a geolocating service to users who transfer electronic documents to that address, said geolocating service involving analyzing electronic documents that are electronically transferred to that address by remotely located client applications and from that analysis generating geolocation information for those electronic files [e.g., Fig.2; paragraphs 10 and 58-59];

identifying at said client application a client document [e.g., map data]; and
electronically transferring the identified client document to the address of the geolocating service so as to receive the geolocating service for the identified client document [e.g., Figs. 4 and 6; paragraph 53]; .

6. As to claim 2, Singh teaches that the method further comprises: electronically receiving back from said server said document and geolocation information that was generated for said document by said server [e.g., paragraphs 42-43].

7. As to claims 3-4, Singh teaches that the method further comprises:

Art Unit: 2154

identifying at a client a plurality of client documents for which geolocation information is desired, said first-mentioned client document being among said plurality of client documents;

electronically transferring the identified plurality of client documents to the address of the geolocating service so as to receive the geolocating service for the identified plurality of client documents; and

electronically receiving back from said geolocating service said plurality of documents and geolocation information that was generated by said geolocating service for each of said plurality of documents [e.g., paragraphs 10-13; Fig. 8; paragraphs 71-73].

8. As to claim 5, Singh teaches that the method further comprises:

electronically receiving back from said geolocating service spatial identifiers that were generated for each of said plurality of documents by said geolocating service [e.g., city names and street names are spatial identifiers shown on a rendered map].

9. As to claim 6, teaches that the method further comprises:

electronically receiving back from said server a spatial document index that was generated for said plurality of documents by said geolocating service [e.g., paragraph 140].

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singh et al.(hereafter "Singh")[U.S. PGPub 20020091758], as applied to claims 1-6 above.

12. As to claims 7-8, Singh does not specifically teach how the address associated with the server is obtained.

However, it is well known in the art of Internet surfing that a user may use a popular search engine to find a desired service and bookmark the address to its local memory.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that a first user of Singh's system to adopt the same approach by searching on the Internet for said address associated with the server that provides a geolocating service to users and subsequently read said address from a local memory

because it is convenient to find a service provider's address by searching the Internet, followed by book-marking the acquired address.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Rossmann et al. [U.S. PGPub 20040111669];

Allen [U.S. PGPub 20030088556];

Sharnoff et al. [U.S. Pat. No. 6314421];

Video et al. [U.S. PGPub 20040010801];

Callan [U.S. Pat. No. 6105023]; and

Shaner [U.S. Pat. No. 5991714].

Conclusion

Examiner note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Art Unit: 2154

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday(8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:


(571) 273-8300 for official communications; and

(571) 273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

August 28, 2007


8/28/07